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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/878,908
Filing Date: June 19, 1997
Appellant(s): LAUTERJUNG, KARL-LUTZ

Timothy N. Trop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 12, 2008 appealing from the Office action mailed February 12, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No. 2001-1407, Decision mailed September 13, 2002, the present application.

Appeal No. 2003-1502, Decision mailed September 29, 2003, now US Patent 6,740,111, a continuation of the present application.

US Serial No. 10/832,159, Appeal Brief filed August 4, 2008. This application is a grandchild application of the present application.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is substantially correct. However, some of the disputed language does not have literal support.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. However, the claims listed in Issue B are not correct. The listed claims should be **claims 65 and 75-79**.

In addition, there was a provisional double patenting rejection given in the Final Office action. It could be held in abeyance but is listed here as Issue C.

C. Whether claim 32 is unpatentable on the ground of nonstatutory obviousness-type double patenting over claims 11 and 12 of copending Application No. 11/496,162.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal. Some references are made to documents in the "Response to Argument" section of the Answer.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 65-73, 75-79 and 81-82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new language ***"planes of the loops being parallel and substantially coplanar"*** lacks original support, as does the language ***"flattened helical coil"*** and ***"helical coil of a plurality of closed loops."*** Based upon the drawing and the original specification, it is not seen how this language can be said to have support therefrom.

With regard to claims 65, 67-73 and 81-82, the language ***"the loop wraps back upon itself"*** or ***"turned back upon itself"***, or ***"each of said loops wrapping back upon itself"*** or ***"wire turned back upon itself"*** lacks original support in that the loops or wire lengths, as disclosed, are not wrapped in one direction for one loop and then turned back in an opposite direction for the next winding.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 65 and 75-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 65, the new language ***"the planes of said loops being parallel and substantially coplanar"*** and in claim 75, the new language ***"coplanar, and substantially parallel"*** is considered indefinite because planes can be either parallel or

coplanar not both since these terms are mutually exclusive. Claims 76-79 are dependent upon claim 75 so they contain the same indefinite language.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 32 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11 and 12 of copending Application No. 11/496,162. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 11 and 12 are read on by the present claim 32 where the second section of claim 32 is equivalent to the second prosthesis of claims 11 and 12 and the fourth prosthesis of claim 32 corresponds to the third prosthesis of claim 12.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(10) Response to Argument

Issue A

MPEP 2163 I B states "[t]he proscription against the introduction of new matter is a patent application (35 U.S.C. 132 and 251) serves to prevent an applicant from adding information that goes beyond the subject matter originally filed. See *In re Rasmussen*, 650 F.2d 1212, 1214, 211 USPQ 323,236 (CCPA 1981)."

In addition, it is noted that a patent applicant can be his own lexicographer (see MPEP 2111.02 IV). However, this redefinition of terms must be done with the original specification in order to avoid the introduction of new subject matter.

On page 16 of the Brief, the Appellant argues that "*a plurality of spring windings can be parallel, of course. They cannot be perfectly coplanar.*" However, the terminology "substantially coplanar", in claim language, encompasses "coplanar" structures. For this reason, this argument appears to contradict itself.

More to the point, the mere disclosed bundle of wires does not inherently or necessarily result in "*loops that are parallel and substantially coplanar*" as claimed; see Figures 1 and 10 as well as page 9, lines 1-5 of the specification pointed out by Appellant as providing support, page 9 of the Brief. In particular, it is not clear that one winding will necessarily form a parallel loop to another winding. For this reason alone, the claims do not appear to have original support.

With regard to the "flattened helical coil" limitation, the Appellant argues that the ring (30) of Figures 1 and 10 is considered a flattened helical coil. However, the Examiner asserts that it is clear from Figure 10 that the ring (30) is round in cross-section. It is not flat in any real sense. Moreover, a helical structure is one that is "*in the shape of a helix of spiral*" where a helix is "*a mathematical curve that lies on a cylinder or cone and makes a constant angle with the straight lines lying in the cylinder or cone*"; MSN Encarta Online Dictionary. Clearly, there is no helical structure in the ring (30) of the present disclosure. Therefore, the claim language "flattened helical coil" lacks original support in two aspects. Claims 65, 66, 69-73, 75-79, and 81-82 contain this language.

Next, the Appellant argues that the claim language "*wraps back*", "*turned back*" or similar language is "*clearly shown in the figures*." However, the Examiner does not see any wires turned back upon themselves in the figures. Moreover, the plain meaning of this language requires a change in direction such that there is a direction change. For example, Marcade (US 5,676,696) discloses a wire turned back on itself to form a tip where element (156) is attached; see Figure 2.

With regard to the argument that "helical coil of a plurality of closed loops", the Appellant argues that a loop closes itself by wrapping 360 degrees. However, the Examiner asserts that since multiple windings are used to make the rings, it is not clear that any of the loops close on themselves in 360 degrees. From the original disclosure, it is not clear that a single winding loops around to contact that same winding after 360 degrees. Therefore, a plurality of such loops is clearly not disclosed.

Issue B

The Appellant argues that since "precise coplanarity" is not required that the present claims are definite. However, as noted in the previously, "substantially coplanar" encompasses coplanar structures so this terminology appears to directly contradict the other modifier "parallel." Since two mutually exclusive features are being claimed for the same element, the claims are considered indefinite.

Issue C

The Appellant did not traverse this provisional rejection so it has been held in abeyance pending the outcome of this appeal.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided by the Appellant in the Appeal Brief filed June 12, 2008.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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